

REMARKS

Applicants hereby add new claims 44-49. Accordingly, claims 1-22 and 24-49 are pending in the present application.

Claims 1-22, and 24-43 stand rejected under the judicially created doctrine of double patenting over claim 1 of U.S. Patent No. 6,336,764. Claims 1, 24, 31, and 41 stand rejected under 35 USC 112, second paragraph, for indefiniteness. Claims 1, 8, 10, 17-18, 21-22, 24, 30-31, and 36-41 stand rejected under 35 U.S.C. 102(b) for anticipation by U.S. Patent No. 5,657,317 to Mahany et al. Claims 2-6, 11-15, 19-20, 25-28, and 32-35 stand rejected under 35 U.S.C. 103(a) for obviousness over Mahany in view of U.S. Patent No. 6,324,387 to Kamgar et al. Claims 7, 9, 16, and 29 stand rejected under 35 U.S.C. 103(a) for obviousness over Mahany in view of U.S. Patent No. 6,353,406 to Lanzl. Claims 42-43 stand rejected under 35 U.S.C. 103(a) for obviousness over Mahany in view of Kamgar and further in view of Lanzl.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to the rejections under 35 U.S.C. §102, the PTO and Federal Circuit provide that §102 anticipation requires that *each and every element* of the claimed invention be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The corollary of this rule is that the absence from a cited §102 reference of *any* claimed element negates the anticipation. *Kloster Speedsteel AB, et al. v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Referring to claim 1, the Office Action at page 3 identifies the master LAN peripheral device as allegedly disclosing the claimed interrogator. The Office Action further identifies the slave LAN peripheral device as allegedly disclosing the claimed remote communication device. Further, the Office Action identifies the slave peripheral device's radio unit as allegedly disclosing the claimed housing. The anticipation rejection of claim 1 over Mahany is in error and Applicants request allowance of claim 1 in the next Action.

For example, the slave peripheral device or circuitry thereof has been identified as allegedly disclosing components of two devices including the remote communication device and the housing of the claimed interrogator. The Office Action has already identified the master LAN peripheral device as allegedly disclosing the claimed interrogator. Accordingly, the rejection is nonsensical inasmuch as the slave LAN peripheral device has been identified as allegedly disclosing both the remote communication device and a component of the interrogator. The rejection is nonsensical inasmuch as the slave peripheral device has been relied upon as disclosing limitations of both of the distinctly claimed different communication entities including the remote communication device and the interrogator.

In view of at least the above authority, it is clear that the limitations of claim 1 are not shown nor suggested by the teachings of Mahany identified in the Office Action and Applicants request allowance for at least this reason.

In the event that a rejection of claim 1 is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of

elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.* Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a *non-final Action* if claim 1 is not found to be allowable.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 10, the Office Action on page 4 identifies the slave LAN peripheral devices as allegedly disclosing the claimed communication stations. The Action further identifies the stations are configured to output a forward link wireless signal comprising the "request to send message." The Office is mistaken and the anticipation rejection is improper.

At col. 51, lines 40-45 of Mahany it is stated that the slave activates and it determines from a "*request to send*" type message *from the master* that the master has

data for transmission to the slave. Accordingly, it is clear that the slave peripheral device identified in the Office Action as disclosing the claimed communication stations in fact receives the "request to send message" and fails to disclose or suggest outputting the forward link wireless signal as clearly claimed. Positively-recited limitations of claim 10 are not shown nor suggested by the prior art and claim 10 is allowable for at least this reason.

Consistent with the MPEP and C.F.R. sections recited above, Applicants respectfully request issuance of a non-final action to cure the deficiencies of the present action if claim 10 is not allowed.

The claims which depend from independent claim 10 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 18, the Office Action at page 5 identifies "transmission of data signals" as allegedly disclosing the claimed generation of the return link communication signals of the claimed communication station. Thereafter, the Action identifies the slave radio unit as allegedly disclosing the receiving of the return link communication signals including "clear to send" messages. The rejection is nonsensical inasmuch as "transmission of data signals" and the "clear to send" messages comprise different messages or signals and fail to disclose or suggest the claimed generation of *return link communication signals* and the reception of the same generated *return link communication signals*.

Further, it is stated on page 5 of the Action, that the "clear to send" message

teachings are received by circuitry of the housing configured to receive the return link communications signals. It is clear from Mahany that the slave (identified as allegedly disclosing the claimed housing) outputs and does not receive the "clear to send" messages. Accordingly, Mahany fails to disclose or suggest any circuitry configured to receive the return link communication signals inasmuch as the "clear to send messages" are outputted by the slave and not received by circuitry of the slave as alleged by the Office Action. Positively-recited limitations of claim 18 are not shown nor suggested by the prior art and claim 18 is allowable for at least this reason.

Consistent with the MPEP and C.F.R. sections recited above, Applicants respectfully request issuance of a non-final action to cure the deficiencies of the present action if claim 18 is not allowed.

The claims which depend from independent claim 18 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 24, the Action identifies on pages 6-7 teachings of Mahany that the "transmission of data signal" allegedly discloses the claimed generating the return link communication signal and the claimed receiving the return link communication signal is taught by operations of the radio unit of the slave LAN peripheral device. Claim 24 positively recites providing an *interrogator and at least one remote communication device*. The Action alleges that the master and slave peripheral devices disclose respective ones of the interrogator and remote communication device. However, the receiving operations

of the slave LAN peripheral device (identified as teaching the remote communication device) fail to disclose or suggest the *receiving the return link communication signal within a housing of the interrogator as claimed*. Positively-recited limitations of claim 24 are not taught nor suggested by the prior art and claim 24 is allowable for at least this reason. Consistent with the MPEP and C.F.R. sections recited above, Applicants respectfully request issuance of a non-final action to cure the deficiencies of the present action if claim 24 is not allowed.

The claims which depend from independent claim 24 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 31, the Action identifies the master LAN peripheral device as allegedly disclosing the claimed interrogator and the slave LAN peripheral device as allegedly disclosing the claimed housing. Claim 31 positively recites providing an *interrogator having a housing and a plurality of communication stations remotely located from the housing*. The rejection of claim 31 is improper inasmuch as Mahany fails to disclose or suggest the *master device having a slave device* as required according to the interpretation of the Mahany teachings by the Office, and accordingly Mahany fails to disclose or suggest the interrogator having a housing as claimed.

The rejection of claim 31 is also improper in view of the allegation on page 7 of the Action that Mahany teaches receiving a return link wireless signal "clear to send" message within the respective communications stations responsive to the communicating the

respective forward link wireless signal via receivers within the slave device's radio unit. The Action identifies radio units of master LAN peripheral devices as allegedly disclosing the claimed communication stations and accordingly any receive operations of the slave device's radio unit fail to disclose or suggest any limitations of claim 31 with respect to receiving of signals within the communication stations. Positively-recited limitations of claim 31 are not taught nor suggested by the prior art and claim 31 is allowable for at least this reason.

Consistent with the MPEP and C.F.R. sections recited above, Applicants respectfully request issuance of a non-final action to cure the deficiencies of the present action if claim 31 is not allowed.

The claims which depend from independent claim 31 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to the rejection of claim 42, the Office relies upon the teachings of three references in support of the obviousness rejection. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed.).

On page 17 of the Action, radio units of the master LAN peripheral device are identified as allegedly disclosing the claimed communication stations. Referring to col. 40, lines 31-37 of Mahany, it is stated that master/slave type protocol is appropriate for peripheral LANs. Further, at col. 40, lines 38-41 of Mahany, it is stated that in a peripheral LAN, *a roaming mobile or portable computing devices and wireless peripherals* may all operate on battery power. Referring to col. 48, lines 34-45 of Mahany, it is stated that master LAN peripheral devices communicate wirelessly with slave devices but also a premises LAN. Referring to Fig. 1c of Mahany, devices 61, 62 are shown as master devices wirelessly communicating with both slave peripherals as well as base stations of the premise LAN. In accordance with the disclosure of Mahany using roaming mobile and portable computer devices as master LAN peripheral devices, there is no motivation to modify the master LAN peripheral devices to communicate via coaxial cables as recited in claim 42. The only motivation can only result from improper reliance upon Applicants' disclosure.

However, the motivation for forming the combination must be something other than hindsight reconstruction based on using Applicants' invention as a road map for such combination. See, e.g., *Interconnect Planning Corp. v. Veil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2nd 1430 (Fed. Cir. 1990) (explaining rejection of a claim).

The Action on page 18 alleges motivation exists in that it would have been obvious to have the coaxial RF cable in order to transmit and receive identification tags' signals. Applicants submit that such is deficient for a proper *prima facie* 103 rejection. At col. 48,

lines 36-41 of Mahany, it is stated that the master devices contain two radio units so the express teachings of Mahany already provide transmission and reception of signals and there is no motivation to additionally configure the master devices to communicate via coax cables in view of the already express reference teachings regarding two radio units. The motivational rationale is redundant in view of the express reference teachings and insufficient to support a 103 rejection.

Further, the Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth rationale on which it relied. Statements set forth in the present Office Action are akin to the alleged motivation discussed *In re Lee* and accordingly are insufficient to combine the reference teachings. The 103 rejection of claim 42 is improper without the proper motivation and Applicants respectfully requests allowance of claim 42 in the next action.

The 103 rejection of claim 42 is improper for at least the above mentioned compelling reasons. Applicants request allowance of claim 42 in the next Action.

The claims which depend from independent claim 42 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to the indefiniteness rejections, Applicants submit claims 1, 24 and 31 are definite. With respect to claims 1 and 24, such claims do not recite that the housing generates return link communication signals as alleged. Accordingly, it is believed that claims 1 and 24 are definite.

With respect to claim 31, such claim properly recites that the return link communication signals are generated, communicated and received. There is no transmitting recited in claim 31. Applicants submit that claim 31 is believed to be definite

Appl. No. 10/081,256
Amdt. Dated May 26, 2004
Office Action mailed 2/26/2004

and request clarification in a non-final action if the indefiniteness rejection of claim 31 is not withdrawn.

Applicants have amended claim 41 as shown. Withdrawal of the indefiniteness rejections is respectfully requested.

Referring to the obviousness-type double patenting rejection, Applicants submit that U.S. Patent No. 6,336,764 is entitled "Adjustable water-guiding rod for a cleaning brush" which fails to disclose claimed subject matter in the instant application. Withdrawal of the obviousness-type double patenting rejection is requested for at least this reason.

Applicants have added new claims 44-49 which are supported at least by Figs. 1 and 6-10 of the originally filed application.

Applicants submit copies of 1449 forms which have references thereon which have not yet been initialed by the Examiner. Applicants request initialization of the references and return of the forms to Applicants.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 5/26/04

By: 
James D. Shaurette
Reg. No. 39,833